REMARKS

By this response, claims 1-102 are pending. Compared to prior versions, claims 1-9, 27-34, and 61-69 remain original, claims 10-26, 35-60, and 70-101 remain withdrawn from consideration, and claim 102 is new.

The Examiner has requested a new title of the invention. The Examiner has also rejected claims 1-9, 27-34, and 61-69 under 35 U.S.C. § 112, second paragraph, as indefinite. In addition, the Examiner has rejected claims 1, 27, and 61 under 35 U.S.C. § 101.

With regard to the request for a new title, the Applicant's specification has been amended to state "PROCESSING PRINT JOBS FOR A RENDERING DEVICE." Thus, the Applicant submits that the new title is specific and descriptive, in accordance with 37 C.F.R. § 1.72 and M.P.E.P. § 606, and that it satisfies the Examiner's request.

With respect to the rejection of claims 1-9, 27-34, and 61-69 under 35 U.S.C. § 112, second paragraph, the Examiner argues that the phrase "requires a hard processing operation," in independent claims 1, 27, and 61, is indefinite. In particular, the Examiner contends that "the specification does not provide a standard for ascertaining the requisite degree" of the term "hard." *Office Action, p. 2, ¶5.* The Applicant respectfully disagrees.

As is well established, an "applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s)." M.P.E.P. § 2111.01 (citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994)); *see also* M.P.E.P. § 2173.01. Further, "[w]here an explicit definition is provided by the applicant for a term, ***that definition will control*** interpretation of the term as it is used in the claim." M.P.E.P. § 2111.01 (citing *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (emphasis added).

In this respect, the Applicant's specification states, "[a]s used herein, a hard processing operation means any math or logic function, previously described, having two or more inputs." *Specification, p. 16, ll. 17-18.* The Applicant's specification also notes that "a math or logic function" is typically specified:

> in a well known manner by the PDL as part of the PDL file, such as a Boolean expression, when the PDL emulator is of PCL language type, or an algebraic expression for PDF languages. As a representative example, a PCL language has 256 possible logic functions. A PDF language has about 16 math or logic functions.

Specification, p. 15, ll. 17-21. Further, the Applicant submits that this definition is clear, precise, and definite in that skilled artisans know that a "math or logic function" can have "inputs" and will understand that to the extent that a "math or logic function" has "two or more inputs," it becomes defined as a "hard processing operation." In addition, because the Applicant's specification specifically sets forth a definition of the term "hard processing operation," this definition ***controls*** the "interpretation of the term as it is used in the claim." M.P.E.P. § 2111.01. Therefore, the Applicant submits that viewing the claims in light of the specification, skilled artisans will understand the subject matter that the Applicant regards as the invention, and that the claims particularly point out and distinctly define the metes and bounds of the subject matter that will be protected. Therefore, the Applicant submits that independent claims 1, 27, and 61, and those claims that depend therefrom, are not indefinite. Accordingly, the Applicant respectfully requests that this rejection be reversed.

Regarding the rejection under 35 U.S.C. § 101, the Examiner argues that claims 1, 27, and 61 do not "set forth completed steps involved in the method/process." *Office Action, p. 3, ¶6.* The Applicant respectfully disagrees.

First, the Applicant submits that claims 1, 27, and 61 clearly include active, positive steps, in accordance with M.P.E.P. § 2173.05(q). For example, claim 1 includes

"constructing a display list object for a to-be-printed object in said print job" and "determining whether any math or logic function of said display list object requires a hard processing operation." Therefore, the Applicant submits that claims 1, 27, and 61 clearly set forth completed steps. Accordingly, the Applicant respectfully requests that this rejection be reversed.

Further, the law defines four categories of inventions, e.g., processes, machines, manufactures and compositions of matter. As mentioned under M.P.E.P. §2106, for example, the latter three categories define "things" or "products," while the first category, "processes," define "'actions' (i.e., inventions that consist of a series of steps or acts to be performed.)" Also, the U.S. Supreme Court has interpreted 35 U.S.C. §101 as broadly including "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 US 303, 308-309, 206 USPQ 193, 197 (1980). Despite the seeming breadth of such an interpretation, it is more narrowly anything under the sun, made by man, other than the "laws of nature, natural phenomena, and abstract ideas." *Diamond v. Diehr,* 450 US 175, 185 (1981). The ultimate issue must also be dissected according to "whether the claim ***as a whole*** is drawn to statutory subject matter." *Emphasis added, AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1451 (Fed. Cir. 1999) (citing to *In re Alappat*, 33 F3d. 526, 31 USPQ2d 1545 (Fed. Cir. 1994), among other cites.).

In the present invention, however, nothing realistically can be construed as a law of nature, a natural phenomena, or an abstract idea. Rather, the invention of independent claims 1, 27, and 61, as a whole, includes structural elements and is drawn to statutory subject matter. Further, the Applicant submits that in accordance with M.P.E.P. § 2106, claims 1, 27, and 61 are practical applications that produce useful, concrete, and tangible results. Specifically, claim 1 includes the structural element of a "rendering device." Moreover, within this structural "rendering device," the invention of claim 1 produces the useful, concrete, and tangible results of "a display list object" and the determination of "whether any

math or logic function of said display list object requires a hard processing operation." Similarly, the invention of claim 27 produces the useful, concrete, and tangible results of a divided "to-be-printed page," "a band display list," and the determination of "whether a math or logic function of any of said band display lists requires a hard processing operation."

With respect to the invention of claim 61, the claim recites a "computer readable media." As explained in the Applicant's specification, "computer readable media can comprise RAM, ROM, EEPROM, CD-ROM or other optical disk storage devices, magnetic disk storage devices." *Specification, p. 8, ll. 3-4.* As has long been held, the foregoing are statutory structures. *See, e.g., In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995) (The Federal Circuit held computer programs as patentable subject matter because of claiming in terms of an article of manufacture, as in a floppy disk.). Further, the invention of claim 61 produces the useful, concrete, and tangible results of "processing a to-be-printed page of a print job" with "a plurality of to-be-printed objects" and "determining whether any math or logic function associated with any of said to-be-printed objects requires a hard processing operation."

In other words, independent claims 1, 27, and 61 contain statutory subject matter that includes structural elements and practical applications, producing the useful, concrete, and tangible result of figuring out how to conduct the processing of a print job received by a rendering device. For at least these additional reasons, the Applicant submits that claims 1, 27, and 61 comply with 35 U.S.C. § 101.

Nonetheless, to further overcome the rejections under 35 U.S.C. § 112 and 35 U.S.C. § 101, the Applicant has added independent claim 102. First, the Applicant submits that claim 102 overcomes the rejection under 35 U.S.C. § 112, as it does not use the term that the Examiner argues is indefinite, "hard processing operation," at all. Instead, claim 102 incorporates the definition of a "hard processing operation" recited in the specification, namely, "any math or logic function, previously described, having two or more inputs." *See*

Specification, p. 16, ll. 17-18. The Applicant notes that this incorporation of the definition of a "hard processing operation" simply replaces the term "hard processing operation," which is already present in the previously presented claims, with its definition, which is already present in the specification. Therefore, this incorporation of the definition of a "hard processing operation" in claim 102 does not add any new matter to the claims. Further, because claim 102 simply replaces the term "hard processing operation," from the previously presented claims, with its definition, the Applicant submits that claim 102 is not an amendment that requires the citation of new art. *See* M.P.E.P. § 706.07 (a). Therefore, the Applicant submits that a new search and the citation of new art are not necessitated.

Further, the Applicant submits that, in accordance with the requirements of 35 U.S.C. § 112 and M.P.E.P. § 2173.02, this definition is definite, clear, and precise. That is, the Applicant submits that skilled artisans will understand the subject matter that the Applicant regards as the invention, and the claims particularly point out and distinctly define the metes and bounds of the subject matter that will be protected. Specifically, skilled artisans will understand the incorporated definition because skilled artisans will understand what a "math or logic function" and "inputs" are and that a "math or logic function" can have "two or more inputs." For at least these reasons, the Applicant submits that claim 102 overcomes the rejection under 35 U.S.C. § 112.

In addition, the Applicant submits that claim 102 complies with the requirements of 35 U.S.C. § 101. First, the Applicant submits that claim 102 overcomes the rejection under 35 U.S.C. § 101 and clearly includes active, positive steps, in accordance with M.P.E.P. § 2173.05(q). Second, the Applicant submits that nothing in claim 102 can realistically be construed as a law of nature, a natural phenomena, or an abstract idea. Rather, the Applicant submits that the invention of claim 102, as a whole, includes structural elements and is drawn to statutory subject matter. Further, the Applicant submits that in accordance with M.P.E.P. § 2106, claim 102 is a practical application that produces useful, concrete, and tangible

results. Specifically, claim 102 includes a structural "rendering device." Claim 102 also produces the useful, concrete, and tangible results of a divided "to-be-printed page," a "band display list," and a determination of "whether any math or logic function" for a to-be-printed object "of said band display lists requires a Boolean or algebraic processing operation having two or more inputs." That is, claim 102 contains statutory subject matter, including structural elements and practical applications, and produces the useful, concrete, and tangible result of figuring out how to conduct the processing of a print job received by a rendering device. Therefore, the Applicant submits that claim 102 complies with the requirements of 35 U.S.C. § 101.

For at least these reasons, the Applicant submits that all pending claims stand in a condition for allowance and respectfully requests a timely Notice of Allowance be issued for same. ***If any additional fees are due, although none are believed due beyond those expressly authorized in the attached form for the extra claim, the undersigned authorizes their deduction from deposit account number 11-0978.***

Respectfully submitted,

KING & SCHICKLI, PLLC

Rebecca Ann Krefft
Reg. No. 58,856

247 North Broadway
Lexington, Kentucky 40507
859/ 252-0889
859/252-0779